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EXAMINER

TRAN, THUY V

ART UNIT

PAPER NUMBER

2821

MAIL DATE

DELIVERY MODE

08/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,848

Applicant(s)

DESISTI ET AL.

Examiner

Thuy V. Tran

Art Unit

2821

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 07/19/07 with amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Applicants' Request for Continued Examination (RCE) filed on 07/19/2007 and an amendment concurrently filed therewith. In virtue of this amendment, claims 4-5 and 11 have been canceled; claims 15-16 are newly added; and thus, claims 1-3, 6-10, and 12-16 are now presented in the instant application.

Request for Continued Examination (RCE) entry

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 07/19/2007 has been entered.

Specification Objections

2. The amendment filed on 07/19/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the specification of the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the specification of the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- "a lamp holder housing" recited in line 9 of claim 1;
- "said bottom of said lamp bottom housing" recited in line 10 of claim 1;
- "said first igniter stage generates approximately 6 kW and having a very low current" recited in lines 2-3 of claim 12;
- "wherein said device works for the duration of lamp ignition which is about 1 second" recited in lines 2-3 of claim 13; and

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- “wherein a high voltage state of igniter is positioned on a mobile carriage under said lamp holder” recited in lines 2-3 of claim 14.

Applicants are required to cancel the new matter in reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations:

- “a lamp holder housing” recited in line 9 of claim 1;
- “said bottom of said lamp bottom housing” recited in line 10 of claim 1;
- “said first igniter stage generates approximately 6 kW and having a very low current” recited in lines 2-3 of claim 12;
- “wherein said device works for the duration of lamp ignition which is about 1 second” recited in lines 2-3 of claim 13; and
- “wherein a high voltage state of igniter is positioned on a mobile carriage under said lamp holder” recited in lines 2-3 of claim 14.

are neither explicitly nor impliedly described in the submitted specification to a person skilled in the art.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-3, 6-10, and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation "said bottom of said lamp bottom housing" in line 10.

There is insufficient antecedent basis for this limitation in the claim.

Claims 2-3, 6-10, and 12-14 are also rejected under 35 U.S.C. 112, second paragraph, since they are dependent on claim 1.

8. Claim 15 recites the limitation "said bottom of said lamp bottom housing" in lines 9-10.

There is insufficient antecedent basis for this limitation in the claim.

Claim 16 is also rejected under 35 U.S.C. 112, second paragraph, since it is dependent on claim 15.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 6-7, and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicants' Admitted Prior Art (AAPA) Figs. 1-2.

With respect to claims 1 and 15, as to the best interpretation, AAPA Figs. 1-2 shows a device for switching on and powering discharge lamps comprising a current limiting device [9],

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a square wave generator (not shown; see specification; page 6, lines 6-7), an igniter [11], two high tension connection cables [15], a lamp holder [16] with a discharge lamp coupled (thereto); said igniter comprises a high tension transformer [12] and overlapping transformers [13, 14]; said device being characterized in that said igniter is divided into a first stage of the igniter, or pulse generator transformer, and the high tension transformer [12], and in that said first igniter stage, or pulse generator transformer, and the high tension transformer [12] are assembled along with the above mentioned components, wherein said device includes a lamp holder housing [3] (see Fig. 1) such that the first igniter stage is fixed on said holder (or "said bottom of said lamp bottom housing" as claimed) and, wherein said at least current limiting device module [9] is connected by two reduced section cables [OUT1, OUT2] to said first stage of the igniter, or pulse generator transformer, and further wherein said current limiting device module [9] and said first stage of the igniter, or pulse generator transformer, are subjected to movement and/or traction (since connection is made with cables [OUT1, OUT2]).

With respect to claim 2, AAPA Fig. 2 shows that the first stage of the igniter, or pulse generator transformer, is fixed to the lamp holder (via cables [15]).

With respect to claim 3, AAPA Fig. 2 shows that the first stage of the igniter, or pulse generator transformer, integrally moves along with the lamp holder (via cables [15]).

With respect to claim 6, AAPA Fig. 2 shows that the first stage of the igniter, or pulse generator transformer, comprises a transformer [13, 14].

With respect to claim 7, AAPA Fig. 2 shows that the first stage of the igniter, or pulse generator transformer, comprises two transformers [13, 14].

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With respect to claims 12-13, it appears that the igniter stage of the device of AAPA Figs. 1-2 generates approximately 6 kW and is operated for the duration of lamp ignition of 1 second (since the device of AAPA Fig. 2 and that of the claimed invention (Fig. 4) are similar to each other, except the length of the connecting cable).

With respect to claim 14, AAPA Fig. 1 shows a high voltage state of igniter is positioned on a mobile carriage under said lamp holder.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 8-10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA Fig. 2 in view of Elliott (U.S. Patent No. 4,414,491).

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With respect to claims 8-10 and 16, AAPA Fig. 2 discloses all of the claimed subject matter, as expressly recited in claims 1 and 6-7, except for each of the transformers being comprised of a toroidal core.

Elliott discloses, in Fig. 1, a transformer being comprised of a toroidal core [33].

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the device of AAPA Fig. 2 by employing the transformers individually configured with a toroidal core so as to obtain a reduction of the net flux when increasing the load current and that of size or dimensions since such an arrangement of the transformers with toroidal cores with the stated purpose has been well known in the art as evidenced by the teachings of Elliott (see col. 3, lines 28-31).

Remarks and conclusion

14. Applicants' arguments filed on 07/19/2007 have been fully considered but they are not persuasive.

In response to the Applicants' argument in the last paragraph at page 6 that "None of the prior art references include a device wherein the first igniter stage is fixed on the bottom of lamp holder housing", it is noted that AAPA Fig. 1 apparently shows such limitation (see details in the "Claim Rejections – 35 USC § 102" section).

In response to the Applicants' argument in the second paragraph at page 7 that "the claims have been amended to incorporate at least two overlapping transformers. This has not been shown in the prior art devices", it is noted that AAPA Fig. 2 apparently shows such limitation (see details in the "Claim Rejections – 35 USC § 102" section).

For the aforementioned:

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- Claims 1-3, 6-7, and 12-15 are now rejected as being anticipated by the teachings of AAPA Figs. 1-2; and
- Claims 8-10 and 16 are now rejected as being unpatentable over the combined teachings of AAPA Figs. 1-2 and Elliott.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy V. Tran whose telephone number is (571) 272-1828. The examiner can normally be reached on M-F (8:00 AM -4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Owens Douglas can be reached on (571) 272-1662. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

08/06/2007



**THUY V. TRAN
PRIMARY EXAMINER**